

### **REMARKS**

Prior to the present amendment, claims 10-12 and 15-24 were pending. By the present amendment, applicants have amended claims 10, 15, 16, 17, 23 and 24, and canceled claim 11. No new matter has been introduced by these amendments. Accordingly, claims 10, 12, 15-24 are under examination.

### **Interview Summary**

Applicants thank Examiner Robinson and Examiner Ibrahim for their time and courtesy extended to Applicants, namely Dr. Nicolas C.M.H de Vetten, assignee's representative, Mr. Bart (L.A.C.M) van Wezenbeek, and Applicants' representatives, Anna C. Chau and Lauren T. Emr, during the personal interview on February 2, 2010. All of the rejections and objections of claims 10-12 and 15-24 from the pending Office Action were discussed.

Applicants thank the Examiners for discussing appropriate claim language to avoid the cited art references, especially Jacobsen (*Euphytica* 44:43-48, 1989), Jacobsen (*Euphytica* 53:247-253, 1991), and Poehlman ("Breeding Potato," *Breeding Field Crops*, Chapter 21, pp. 419-433, 1995) references. An agreement was reached on possible claim language to obviate the rejections of record. Applicants note that although an agreement was reached, the Examiner reserved the right to conduct an additional art search in order to determine whether the claims were in condition for allowance.

### **Claim Objections**

On pages 2-3 of the office action, the examiner objects to claims 23-24. In response, applicants have amended the claims according to the examiner's suggested language. Applicants thank the examiner for his suggested amendments, and respectfully request reconsideration and withdrawal of the objections.

On page 3 of the office action, the examiner objects to claims 23-24 as being in a multiple dependent claim form. Applicants respectfully submit that claims 23-24 are not in multiple dependent claim form and are, therefore, entitled to be further treated on the merits. Applicants respectfully request reconsideration and withdrawal of the objection.

**Rejection under 35 U.S.C. § 103(a)**

On pages 3-6 of the office action, the examiner rejects claims 10-12 and 15-24 as being unpatentable under §103(a) in view of Jacobsen (*Euphytica* 44:43-48, 1989), Jacobsen (*Euphytica* 53:247-253, 1991), Poehlman ("Breeding Potato," *Breeding Field Crops*, Chapter 21, pp. 419-433, 1995), and Farran (*Transgenic Research* 11:337-346, 2002).

Applicants respectfully disagree. As explained in § 2143.02 of the MPEP, a *prima facie* case of obviousness requires a reason why one of skill would have a reasonable expectation of success in arriving at the claimed invention. Even after *KSR*, the requirement for a reasonable expectation of success remains.

As discussed during the interview, Applicants respectfully submit that the Office Action did not set forth a reasonable expectation of success to support a *prima facie* case of obviousness. The Office Action does not point out why a skilled artisan would expect that an allele relating to amylose-free starch (see Jacobsen) would increase protein storage capacity. None of the cited references provide any nexus between an allele relating to amylose-free starch and protein content and/or storage capacity, or a nexus between any allele relating to starch and protein content and/or storage capacity.

Moreover, the Office Action does not explain why one of skill in the art, given the cited reference and common knowledge in the art, would have reasonably expected that the *amf*-allele would affect protein storage capacity. Without more, one of skill in the art would have no reason to select the *amf*-allele to affect protein storage capacity in potato plants.

In conclusion, the Office Action has not provided a sound basis for having a reasonable expectation of success that the *amf*-allele would affect protein content and/or storage capacity in potato plants. Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

### **Claims**

Step (a) of claims 10 and 16 have been amended to delete the phrase, “lacking an *amf* allele” merely in order to clarify the claims, i.e., not to overcome art. The claimed invention does not require that the second plant lacks an *amf* allele. See, for example, original dependent claim 12 and previously presented dependent claim 17, which allow for progeny that are homozygous for the *amf* allele. Such progeny may be obtained, for example, by crossing a first and second potato plant having an *amf* allele. See, for example, the disclosure on page 2, line 33, to page 3, line 19 in the specification.

**Conclusion**

In view of the foregoing amendments and remarks, entry of the amendments and favorable consideration of the claims are respectfully requested. If the examiner has any questions or concerns regarding this amendment, he is invited to contact the undersigned at the telephone number listed below.

If any fees are due or any over overpayment made in connection with this submission, please charge or credit our Deposit Account No.: 08-2461 for such sum.

Respectfully submitted,

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